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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/213,858	12/16/1998	SCOTT ANTHONY MORGAN	AT9-98-344	6316

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EXAMINER

ARMSTRONG, ANGELA A

ART UNIT	PAPER NUMBER
2654	12

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 12

Application Number: 09/213,858

Filing Date: December 16, 1998

Appellant(s): MORGAN ET AL.

J. B. Kraft
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed January 22, 2002.

Art Unit: 2654

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

The rejection of claims 1-15 stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

(8) *ClaimsAppealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

Art Unit: 2654

(9) Prior Art of Record

6,088,671	GOULD ET AL	11-2000
5,748,841	MORIN ET AL	5-1998

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-15 are rejected under 35 U.S.C. 103(a). This rejection is set forth in prior Office Action, Paper No. 7.

(11) Response to Argument

In response to applicant's argument that there is no suggestion from Gould et al to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

In this case, Morin specifically teaches a computer speech recognition system which receives speech input from the user, processes the speech input and determines if the speech input is related or representative of valid commands, and identifies to the user said valid system commands applicable to a computer application or program (col. 19, line 20 – col. 20, line 64). Morin also teaches that one advantage of the system is that it allows users who are unfamiliar

Art Unit: 2654

with available commands of an application to progressively build sentences, which will have meaning to the application (col. 1, lines 15-20).

Therefore, the teaching, suggestion, or motivation to combine the references of Gould et al and Morin et al can be found within the Morin et al reference.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

In this instance, Morin specifically teaches a computer speech recognition system which receives speech input from the user, processes the speech input and determines if the speech input is related or representative of valid commands, and identifies to the user said valid system commands applicable to a computer application or program (col. 19, line 20 – col. 20, line 64). Morin also teaches that one advantage of the system is that it allows users who are unfamiliar with available commands of an application to progressively build sentences, which will have meaning to the application (col. 1, lines 15-20).

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

AAA/aaa
March 24, 2002

Conferees

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